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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,588	10/29/2001	Masamichi Ipponmatsu	F-7204	8133

28107 7590 03/26/2003
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EXAMINER

BELL, BRUCE F

ART UNIT	PAPER NUMBER
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1746

DATE MAILED: 03/26/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/005,588

Applicant(s)

Ipponmatsu et al

Examiner

Bell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in the prior office action. Since applicants have not responded to the prior office action, the rejection stands and has been restated below.

Claim Rejections - 35 USC § 102/103

1. Claims 1-4 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Suzuki et al (pg. 584-591).

Suzuki et al disclose a cermet electrode comprising at least one of grains of a high melting point metal having a melting point of not less than 1900⁰ C and secured in position by zirconia where said grains of the metal have an average diameter of not larger than 10 μ m (abstract and Table 1).

Suzuki et al disclose that the metal is ruthenium (abstract) and that the zirconium is stabilized with yttrium (page 586, "Electrodes").

Response to Amendment

In regards to Suzuki et al., although Applicants are arguing the benefits of the particular grain size and the process of making the product and have tried to show comparative data between the claimed particle size and particle sizes outside the claimed range to distinguish the instant invention as well as clarify the electrochemical vapor deposition process to overcome the prior art rejection, the 1.132 declaration filed January 25, 1994 appears to show the same values

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as in the instant Example 2. However, Example 2 does not disclose the resistance value although this value is cited in the response. The resistance value from Example 2 of the instant specification must be submitted in 1.132 declaration form not just presented in formal arguments. Without the resistance value of Example 2 in declaration form, the present 1.132 declaration suggests to one of ordinary skill in the art that the instant electrode does not appear to be dependent upon the grain size of the high melting metal. Therefore, the grain size is still given little patentable weight.

The use of very small grains or particles to increase surface area is a well known engineering and scientific principle absent evidence to the contrary and taught by Suzuki et al at Table 1.

Suzuki et al do not disclose that the electrode is produced by EVD method (abstract) which is contrary to Applicants' statement on page 2 of the response filed January 21, 1994. Therefore, it is unclear to the Examiner as to how the electrode of Suzuki et al materially differs from the instant invention since Suzuki et al disclose, like Applicants, that an electrode of ruthenium having a grain size as instantly claimed which is secured by yttrium stabilized zirconium is taught and the electrode is produced by the same method as argued.

For the reasons stated above and in the prior Office actions of May 18 and October 21, 1993; March 21, 1994; May 4, 1995; July 03, 1996, August 18, 1997 and September 23, 1998, October 13, 1999, and September 26, 2000, the claims stand rejected.

Applicant's arguments filed January 21, 1994 have been fully considered but they are not deemed to be persuasive.

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Conclusion

2. This is a continuation of Application No. 08/864437 which is an FWC of applicant's earlier Application No. 08/611835.. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire **THREE MONTHS** from the date of this action. In the event a first response is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce Bell whose telephone number is 703-308-2527. The examiner can normally be reached on Monday through Friday from 6:30 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (703) 308-4333. The fax phone number for the

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organization where this application or proceeding is assigned is 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

BFB

March 24, 2003

Bruce Bell
BRUCE F. BELL
PRIMARY EXAMINER
GROUP 1100